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In re Application of
SABANATHAN, Thirumani
Application No.: 09/762,692
PCT No.: PCT/GB98/00652
Int. Filing Date: 03 March 1998
Priority Date: 30 April 1997
Attorney Docket No.: 007-001
For: OCCLUSION DEVICE

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on applicant's "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 09 February 2001.

BACKGROUND

On 03 March 1998, applicant filed international application PCT/GB98/00652 which claimed a priority date of 30 April 1997 and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 November 1998.

A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999.

On 09 February 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee, a copy of the international application, and the present petition seeking revival under 37 CFR 1.137(b) with the appropriate fee.

DISCUSSION

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to authorize the Commissioner to revive an "unintentionally" abandoned application without a showing that the delay in prosecution was "unavoidable." 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). The circumstances of the above-identified application raise a question whether the delay was "unintentional":

Where the applicant deliberately permits an application to become abandoned (*e.g.*, due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). . . . An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 86 (October 21, 1997)(citations omitted).

A review of the application file and specifically the "Declaration by Mark Lunt" reveals that the entire delay cannot be held to be unintentional. In the declaration, it is stated that "[d]ue to my mistaken belief that the (Bradford Hospitals NHS Trust) Trust owned all patent rights, I followed the instructions by the Trust not to file a U.S. National Phase Application." Therefore, in view of the deliberately chosen course of action to not persist in seeking the revival of the abandoned application, the delay cannot be considered to be unintentional, and the petition may not be properly granted.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED** with regards to national stage processing in the United States.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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